

United States District Court

Northern

DISTRICT OF

HOME DIAGNOSTICS, INC., a Delaware corporation,

v.

E-filing

SUMMONS IN A CIVIL ACTION

CASE NUMBER: C -

LIFESCAN, INC., a California corporation,

C01-20725JW
ADR PVT

TO: (Name and address of defendant)

LIFESCAN, INC.
c/o of CT Corporation System, Inc.
Agent of Service for Defendant LifeScan, Inc.
818 W. 7th Street, Floor 2
Los Angeles, CA 90017-3407

YOU ARE HEREBY SUMMONED and required to serve upon **PLAINTIFF'S ATTORNEY** (name and address)

Scott R. Mosko, Esq.
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
700 Hansen Way
Palo Alto, CA 94304-1016

an answer to the complaint which is herewith served upon you, within twenty (20) days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. You must also file your answer with the Clerk of this Court within a reasonable period of time after service.

RICHARD W. WIEKING

JUL 31 2001

CLERK

DATE

(BY) DEPUTY CLERK

Leyva f-Carfilo

United States District Court

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RICHARD W. WIEKING, CLERK
U.S. DISTRICT COURT
N.D. DIST. OF CA

1 Scott R. Mosko (State Bar No. 106070)
2 Robert F. McCauley (State Bar No. 162056)
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
3 Stanford Research Park
700 Hansen Way
4 Palo Alto, California 94304
Telephone: (650) 849-6600
5 Facsimile: (650) 849-6666

6 Of Counsel:

7 Barbara C. McCurdy
Herbert H. Mintz
8 Leslie I. Bookoff
Kathleen A. Daley
9 FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
10 1300 I Street, N.W.
Washington, D.C. 20005
11 Attorneys for Plaintiff
HOME DIAGNOSTICS, INC.

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RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE

E-filing

13 UNITED STATES DISTRICT COURT

14 NORTHERN DISTRICT OF CALIFORNIA

15 SAN JOSE DIVISION

16 C01-20725 JW PVT

17 HOME DIAGNOSTICS, INC.,
a Delaware corporation

18 Plaintiff,

19 v.

20 LIFESCAN, INC.,
a California corporation,

21 Defendants.

CASE NO. ADR

COMPLAINT FOR DECLARATORY
JUDGMENT

DEMAND FOR JURY TRIAL

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1 Plaintiff, Home Diagnostics, Inc. ("HDI"), alleges as follows for its declaratory judgment
 2 complaint against LifeScan, Inc. ("LifeScan"):

3 **Jurisdiction and Venue**

4 1. HDI brings this civil action under the Patent Laws, Title 35 of the United States
 5 Code, and under 28 U.S.C. § 2201 to obtain a declaration of noninfringement with respect to
 6 LifeScan's United States Patent No. 6,268,162, sometimes hereinafter referred to as "the patent at
 7 issue in this Complaint". Since this action arises under the Patent Laws of the United States, this
 8 Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

9 2. Venue in this judicial district is proper under 28 U.S.C. § 1391(b) and 1400 (b).

10 **Parties**

11 3. HDI is a corporation organized and existing under the laws of Delaware, with a
 12 principal place of business at 2400 N.W. 55th Court, Ft. Lauderdale, Florida, 33309.

13 4. HDI is engaged in the design, development, manufacture, marketing, and sale of
 14 devices useful for measuring the level of glucose in human blood.

15 5. LifeScan is a corporation organized and existing under the laws of the State of
 16 California, with a principal place of business at 1000 Gibraltar Drive, Milpitas, California 95035.

17 6. LifeScan is also engaged in the design, development, manufacturing, marketing, and
 18 sale of devices useful for measuring blood glucose level, and competes with HDI.

19 **Factual Background: Declaratory Relief**

20 7. On July 31, 2001, United States Patent No. 6,268,162 issued to LifeScan.

21 8. Upon information and belief, LifeScan is the owner of the entire right, title, and
 22 interest in the patent at issue in this Complaint.

23 9. LifeScan's past conduct in attempting to enforce the patent at issue in this Complaint
 24 and related patents against HDI's commercial blood glucose meters evidences a pattern of
 25 aggressive litigation. LifeScan first sued HDI in this Court in December of 1992, alleging that
 26 HDI's then-current line of blood glucose meters sold under the name "Ultra" infringed the method
 27 claimed in United States Patent No. 5,049,487 ("the '487 patent"), a patent related to the patent at
 28 issue in this Complaint. See *LifeScan, Inc. v. Home Diagnostics, Inc.*, No. 92-20811 SW (N.D. Cal.

1 May 18, 1994) ("*LifeScan I*"). On HDI's motion, this Court issued an Order granting summary
 2 judgment of noninfringement in favor of HDI. On appeal, this Court's ruling was affirmed-in-part,
 3 reversed-in-part, and the case was remanded. See *LifeScan, Inc. v. Home Diagnostics, Inc.*, 76 F. 3d
 4 358 (Fed. Cir. 1996).

5 10. With *LifeScan I* still pending in this Court, on December 6, 1996, LifeScan filed a
 6 second lawsuit on the '487 patent against HDI-this time in a different court (the U.S. District Court
 7 for the District of Delaware) and with respect to a new HDI product, the "Prestige" meter. See
 8 *LifeScan v. Home Diagnostics, Inc. et al.*, No. 96-597 (JJF) ("*LifeScan II*"). In *LifeScan II*, LifeScan
 9 alleged that use of the Prestige meter directly infringed the '487 patent both literally and under the
 10 doctrine of equivalents, and that HDI contributorily infringed and induced others to infringe the '487
 11 patent. After a jury verdict of infringement based on the doctrine of equivalents, on June 21, 2000,
 12 the Delaware District Court granted HDI Judgment as a Matter of Law, ruling that no reasonable
 13 juror could have found infringement, either literally or under the doctrine of equivalents. On April
 14 6, 2001, the Federal Circuit Court of Appeals affirmed the Judgment in HDI's favor.

15 11. Shortly before the start of trial in *LifeScan II*, LifeScan attempted to amend the
 16 complaint to allege that the Prestige meter and its use infringed United States Patent No. 5,849,692
 17 ("the '692 patent"), another patent related to patent at issue in this Complaint. The Delaware Court
 18 denied LifeScan's motion to amend its complaint concerning the '692 patent.

19 12. On December 30, 1999, HDI filed a declaratory judgment action in the Northern
 20 District of California seeking an order that HDI's commercial blood glucose meters, the Prestige and
 21 new products the Prestige LX and the Prestige Smart System, do not infringe LifeScan's '487 or
 22 '692 patents. LifeScan responded by filing a counterclaim against HDI for infringement of its '487
 23 and '692 patents. See *Home Diagnostics, Inc. v. LifeScan, Inc.* No. C-99 21269 (JW) (RS).
 24 (*LifeScan III*).

25 13. In *LifeScan III*, on October 26, 2000, this Court issued an order holding that LifeScan
 26 was precluded from bringing an action against HDI on its '487 patent based on the Delaware District
 27 Court's judgment of noninfringement and the collateral estoppel doctrine.
 28

14. Also in *LifeScan III*, LifeScan stated in a case management conference statement, filed on or about March 9, 2001, that “[it] expects to file a motion to amend its Answer and Counterclaim to add a claim for infringement of its soon to be issued patent, which patent is part of the same patent family as the 487 and 692 Patents.” HDI is informed and believes that this “soon to be issued patent” is the patent at issue in this Complaint.

15. Also in *LifeScan III*, on April 23, 2001, this Court granted HDI's motion for summary judgment, finding that as a matter of law HDI's commercial blood glucose meters, the Prestige, the Prestige LX and the Prestige Smart System, do not infringe LifeScan's '692 patent.

First Count: Declaratory Judgment of
Noninfringement of the Patent at Issue in this Complaint

16. HDI incorporates the allegations of paragraphs 1 - 15.

17. In view of LifeScan's demonstrated willingness to assert each of its admittedly related patents to the patent at issue in this Complaint against HDI concerning its commercial blood glucose meters, and LifeScan's admission in the case management conference statement in *LifeScan III* that it would amend its complaint to assert infringement of its "soon to be issued patent", HDI understands, is apprehensive of, and fully believes and expects that LifeScan intends to bring an action asserting HDI's commercial blood glucose meters infringe the patent at issue in this Complaint.

18. There is an actual controversy between HDI and LifeScan as to the infringement of the patent at issue in this Complaint because LifeScan has expressly charged and is expressly charging that HDI's commercial blood glucose meters are infringing.

19. The patent at issue in this Complaint is not infringed by use of HDI's commercial blood glucose meters, either literally or under the doctrine of equivalents. HDI is not inducing and has not induced users of its commercial blood glucose meters to infringe the patent at issue in this Complaint. Nor has HDI contributed to the infringement of the patent at issue in this Complaint. A judicial declaration of this noninfringement is needed. Therefore, by this claim for relief, HDI seeks a declaration that the use of its commercial blood glucose meters does not infringe any claim of the

patent at issue in this Complaint, and that HDI is not liable for inducing or contributing to infringement of any claim of the patent at issue in this Complaint.

Second Count: Declaratory Judgment of
Invalidity of the Patent at Issue in this Complaint

20. HDI incorporates the allegations of paragraphs 1 - 19.

21. The patent at issue in this Complaint is invalid under one or more provisions of Title 35 of the United States Code. Therefore, by this claim for relief, HDI seeks a declaration that the Patent at issue in this Complaint is invalid.

Prayers for Relief

WHEREFORE, HDI prays that:

(a) A declaratory judgment be entered adjudging and declaring that use of HDI's commercial blood glucose meters does not infringe any claim of the patent at issue in this Complaint, that HDI is not liable for inducing users of its commercial blood glucose meters to infringe any claim of the patent at issue in this Complaint, and that HDI is not liable for contributing to infringement of any claim of the patent at issue in this Complaint;

(b) A permanent injunction be entered enjoining LifeScan, its officers, agents, directors, servants, employees, subsidiaries, assignees, and all those acting under the authority or in privity with them or with any of them who receive actual notice of the injunction, from asserting or otherwise seeking to enforce the patent at issue in this Complaint against HDI's commercial blood glucose meters;

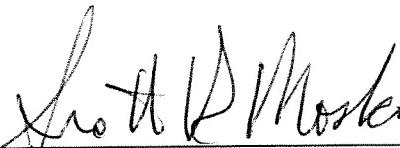
(c) An Order be entered requiring LifeScan to notify in writing each person whom LifeScan and/or its attorneys have contacted regarding any allegations of infringement of the patent at issue in this Complaint that use of HDI's commercial blood glucose meters do not infringe any claim of the patent at issue in this Complaint, that HDI has not induced users of its commercial blood glucose meters to infringe any claim of the patent at issue in this Complaint, and that HDI has not contributed to infringement of any claim of the patent at issue in this Complaint;

(d) A declaratory judgment be entered adjudging and declaring that the patent at issue in this Complaint is invalid and unenforceable;

- 1 (e) HDI be awarded its attorneys' fees, costs, and expenses incurred in this action; and
2 (f) HDI be granted such other and further relief as the Court deems just, equitable, and
3 proper.

4 Dated: July 31 2001

5 FINNEGAN, HENDERSON, FARABOW,
6 GARRETT & DUNNER, L.L.P.
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Scott R. Mosko, Attorneys for Plaintiff
Home Diagnostics, Inc.

1 CERTIFICATION OF INTERESTED ENTITIES OR PERSONS

2 Pursuant to Civil L.R. 3-16, the undersigned certifies that as of this date, and to the best of
3 his knowledge, there is no such interest to report.

4 Dated: July 31, 2001

5 FINNEGAN, HENDERSON, FARABOW,
6 GARRETT & DUNNER, L.L.P.

7 By:

8 
Scott R. Mosko, Attorneys for Plaintiff
Home Diagnostics, Inc.

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13 JURY DEMAND

14 Plaintiff Home Diagnostics, Inc. demands a jury trial as to all issues so triable in this action.

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16 Dated: July 31, 20001

17 FINNEGAN, HENDERSON, FARABOW,
18 GARRETT & DUNNER, LLP

19 By:

20 
Scott R. Mosko, Attorneys for
Plaintiff, Home Diagnostics, Inc.

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27

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1 Scott R. Mosko (State Bar No. 106070)
2 Robert F. McCauley (State Bar No. 162056)
2 FINNEGAN, HENDERSON, FARABOW,
3 GARRETT & DUNNER, L.L.P.
3 Stanford Research Park
4 700 Hansen Way
5 Palo Alto, California 94304
Telephone: (650) 849-6600
5 Facsimile: (650) 849-6666

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9 FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
10 1300 I Street, N.W.
Washington, D.C. 20005
11 Attorneys for Plaintiff
12 HOME DIAGNOSTICS, INC.

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14 UNITED STATES DISTRICT COURT
15 NORTHERN DISTRICT OF CALIFORNIA

16 SAN JOSE DIVISION

17 C01-20725 JW

PVT

18 HOME DIAGNOSTICS, INC.,
a Delaware corporation

CASE NO. C - ADR
NOTICE OF RELATED CASE

19 Plaintiff,

20 v.

21 LIFESCAN, INC.,
a California corporation,

22 Defendants.

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Pursuant to Civil L. R. 3-12, Plaintiff Home Diagnostics, Inc. (“HDI”) brings the attention of this Court to *Home Diagnostics, Inc. v. LifeScan, Inc.*, Civil No. 99-21269 JW (“*HDI I*”), a case that was previously pending before the Honorable James Ware.

HDI and Defendant LifeScan, Inc. (“LifeScan”) manufacture and sell commercial blood glucose meters. Judge Ware presided over *HDI I*, in which LifeScan asserted that HDI’s commercial blood glucose meters infringe two of LifeScan’s patents. The current case concerns yet another patent that LifeScan admits is in the same family as those at issue in *HDI I*, and involves nearly identical devices. More specifically, LifeScan patents, United States Letters Patent No. 5,049,487 (“the ‘487 patent”) and United States Letters Patent No. 5,843,692 (“the ‘692 patent) stem from and claim priority to the same original patent application, and together claim methods and an apparatus for measuring the concentration of an analyte, such as glucose, in a fluid, such as blood. In *HDI I*, LifeScan alleged claims that HDI’s commercial blood glucose meters infringed both the ‘487 and ‘692 patents. Indeed, LifeScan itself admitted that the patent currently at issue was directly related to those that were before Judge Ware in *HDI I*. In a Joint Case Management Conference Statement, filed on or about March 9, 2001, LifeScan represented that this new patent was “part of the same patent family as the ‘487 and ‘692 patents.” Thus, LifeScan argued that Judge Ware should allow it to amend its counterclaim to add this new patent to *HDI I*, once the new patent issued. The Court never acted on LifeScan’s request because on April 23, 2001, it granted summary judgment in favor of HDI before LifeScan’s new admittedly-related patent issued. It is this “new patent” that is at issue in this action.

In *HDI I*, the Court was asked to determine whether HDI’s commercial blood glucose meters infringe the ‘487 patent and the ‘692 patent. Like Judge Ware did in *HDI I*, the Judge assigned to the present action will have to learn the relevant technology, study the teachings of the patent at issue and the related ‘487 and ‘692 patents, familiarize himself or herself with the patent at issue and the related ‘487 and ‘692 patents and their file wrappers, and determine the proper scope of the claims of the new patent.

Both the present action and the related *HDI I* case thus involve a dispute between identical parties, concern a patent that LifeScan admits derived from the same family of patents with which

1 Judge Ware has detailed familiarity, and will involve substantially the same questions of law which
2 Judge Ware recently addressed. In light of the significant commonality of both actions, assignment
3 of this case to Judge Ware is likely to conserve judicial resources and promote an efficient
4 determination of the action. Judge Ware has a level of familiarity with the parties, the admittedly
5 related '487 and '692 patents to the patent at issue in the current Complaint, and the patented
6 technology unlike any other Judge in this District. It therefore appears likely that there will be an
7 unduly burdensome duplication of labor and expense if the present action is assigned to a Judge
8 other than Judge Ware.

9 In addition to *HDI I*, there were two other cases involving a dispute between LifeScan and
10 HDI over this same family of patents. One was venued in the Delaware District court, (*LifeScan v.*
11 *Home Diagnostics, Inc.* No. 96-597 (JJF)), the other was assigned to Judge Williams of this Court
12 (*LifeScan Inc. v. Home Diagnostics, Inc.* No. 92-20811 SW). Each of these other cases has been
13 resolved.

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15 Dated: July 31, 2001

FINNEGAN, HENDERSON, FARABOW,
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18 By:



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